

REMARKS

Claims 1-6, 8-14 and 16-24 are currently pending in the subject application, and are presently under consideration. Claims 8-14 and 16-24 are withdrawn. Claims 1-6 are rejected. Claim 1 has been amended. Claims 19-24 have been cancelled. Claims 25-31 have been added. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

I. Rejection of Claim 1 Under 35 U.S.C. §103(a)

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,148,261 to Obradovich, *et al.* ("Obradovich") in view of U.S. Patent No. 5,160,807 to Fry, *et al.* ("Fry"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

As noted by the Board of Patent Appeals and Interferences in *Ex Parte Wada and Murphy*, Appeal 2007-3733 (2007):

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

It is respectfully submitted that the Examiner has failed to illustrate a suggestion in the cited art of all elements of the claimed invention. Specifically, there is no teaching or suggestion

of a communication module, containing the recited elements, that can be connected to the handheld computing device and removed from the handheld computing device without substantial invasion of the handheld computing device. The Examiner cites *Nerwin v. Erlichman*, 168 USPQ 177 (BPAI 1969) for the proposition that constructing a formerly integral structure in various elements involves only routine skill in the art. It is respectfully submitted, however, that *Nerwin* does not stand for this proposition. When faced with a similar argument, the Board of Patent Appeals and Interferences, in *Ex parte Gruden*, Appeal No. 97-1147 (1997), stated that “We find no such ‘holding’ in *Nerwin*. The only statement in that case which we think may be referred to by the examiner is one which indicates that ‘[t]he mere fact that a given structure is integral does not preclude its consisting of various elements.’ This statement, in our view, is a construction of the term ‘integral,’ and does not appear to stand for the proposition the examiner now urges” *Nerwin*, at pgs. 7-8 (citations shortened). See also *Ex parte Geiger*, Appeal No. 1999-0074 at pgs. 8-9 (BPAI 1999); *Ex parte Holmes*, Appeal No. 96-3077 at pg. 9 (BPAI 1996); *Ex parte Suzuki*, Appeal No. 95-2600 at pg. 11 (BPAI 1995) (“No per se rules of obviousness exist.”). Since the Examiner has provided no basis for a teaching or suggestion of the recited modularity beyond *Nerwin*, it is respectfully submitted that the Examiner has failed to lay out a prima facie case of obviousness for claim 1.

It is further submitted that one of skill in the art, relying on the teachings of Fry, would not seek to create the communications module recited in claim 1. As noted in Fry, “[t]he purpose of the present invention is to provide RFI and EMI protection to a portion of an electronic circuit where the entire circuit, including RFI filters and external connections, is mounted on a single circuit board in a single enclosure.” Fry at Col. 1, lines 26-30 (emphasis added). This object of the Fry patent is repeated at Col 2, lines 14-18, which notes “[a] further object of the present invention is to provide both RFI and EMI protection for at least part of the circuitry on a single circuit board, which is simple in design, rugged in construction and economical to manufacture.” Given the clearly stated purpose of the Fry patent to provide EMI protection to a portion of a circuit board without the need to utilize a second board for the shielded components, it is respectfully submitted that separating the transceiver and GPS from

the computing device into a separate module, as proposed by the Examiner, would be contrary to the stated inventive principle of the Fry patent. An obviousness rejection based on such a modification is improper. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). It is thus respectfully submitted that claim 1 is patentable over the cited art, and the withdrawal of this rejection is respectfully requested.

II. Rejection of Claim 2 Under 35 U.S.C. §103(a)

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Fry as applied to claim 1, and further in view of U.S. Publication No. 2003/0032426 to Gilbert, *et al.* ("Gilbert"). Claim 2 depends from claim 1, and is allowable for at least the same reasons. Gilbert does not remedy the deficiencies of Obradovich and Fry with respect to claim 1, as described previously. It is thus respectfully submitted that claim 2 is patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

III. Rejection of Claim 3 Under 35 U.S.C. §103(a)

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Fry as applied to claim 2, and further in view of U.S. Publication No. 2005/0162334 to Saunders, *et al.* ("Saunders"). Claim 3 depends, through claim 2, from claim 1, and is allowable for at least the same reasons. Saunders does not remedy the deficiencies of Obradovich and Fry with respect to claim 1, as described previously. It is thus respectfully submitted that claim 3 is patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 4 and 5 Under 35 U.S.C. §103(a)

Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Lionetta as applied to claim 1, and further in view of "Xilinx" by Bielby ("Bielby"). Each of claims 4 and 5 depend from claim 1, and is allowable for at least the same reasons. Bielby does not remedy the deficiencies of Obradovich and Fry with respect to claim 1,

as described previously. It is thus respectfully submitted that claims 4 and 5 are patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Fry as applied to claim 1, and further in view of U.S. Publication No. 2005/0114553 to Lada, *et al.* ("Lada"). Claim 6 depends, through claim 5, from claim 1, and is allowable for at least the same reasons. Lada does not remedy the deficiencies of Obradovich and Fry with respect to claim 1, as described previously. It is thus respectfully submitted that claim 6 is patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

VI. New Claims 25-31

Claims 25-31 have been added to further illustrate a modular communications module in accordance with an aspect of the present invention. Support for claims 25-28 can be found in FIGS. 11 and 12 and the accompanying text. Support for claims 29-31 can be found in FIG. 1 and the accompanying text.

Claim 25 depends from claim 1, and is patentable for at least the reasons discussed with respect to claim 1. Further, claim 25 recites a computer readable medium storing executable instructions, the executable instructions being configured such that, when loaded onto the handheld computing device, the handheld computing device is adapted to receive the location of the communications module from the global positioning system, receive the location data for each of the plurality of other communications modules from the L-band transceiver control, and display the locations of each of the communications module and the plurality of other communications modules on a display associated with the handheld computing device. The cited art, taken alone or in combination, does not teach or suggest executable instructions for receiving the locations of a plurality of other devices and displaying their location on a handheld device. It is thus respectfully submitted that claim 25 is patentable over the cited art. Claims 26-28 depend

from claim 25, and are patentable for at least the same reasons. It is thus respectfully submitted that claims 25-28 are allowable.

Claim 29 depends from claim 1, and is patentable for at least the reasons discussed with respect to claim 1. Further, claim 29 recites that the electrically conductive enclosure comprising a conductive back plate configured such that at least a portion of the handheld computing device can be mechanically mounted to the conductive back plate. The cited art, taken alone or in combination, does not teach or suggest this element. It is thus respectfully submitted that claim 29 is patentable over the cited art. Claims 30 and 31 depend from claim 29, and are patentable for at least the same reasons. It is thus respectfully submitted that claims 29-31 are allowable.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

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/Christopher P Harris/

Christopher P. Harris
Registration No. 43,660

Customer No.: 26,294

Tarolli, Sundheim, Covell, & Tummino LLP
1300 East Ninth Street, Suite 1700
Cleveland, Ohio 44114
Phone: (216) 621-2234
Fax: (216) 621-4072